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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,893	08/18/2003	Edgar Evert Steenwinkel	ACH2958	3354

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HOWREY LLP
c/o IP Docketing Department
2941 FAIRVIEW PARK DRIVE
SUITES 200 & 300
FALLS CHURCH, VA 22042

EXAMINER	
VANOY, TIMOTHY C	

ART UNIT	PAPER NUMBER
1754	

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/642,893	STEENWINKEL ET AL.	
	Examiner	Art Unit	
	Timothy C. Vanoy	1754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☒ Claim(s) *5 and 6* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 December 2003* is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *06/28/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The information disclosure statement date-stamped Jan. 20, 2004 does not fully comply with the requirements of 37 CFR 1.98(b) because the reference titled "International Search Report of corresponding PCT Application No. PCT/EP03/09032, dated November 25, 2003" is missing. Since the submission appears to be *bona fide*, applicant is given **ONE (1) MONTH** from the date of this notice to supply the above mentioned omissions or corrections in the information disclosure statement. NO EXTENSION OF THIS TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136(a) OR (b). Failure to timely comply with this notice will result in the above mentioned information disclosure statement being placed in the application file with the noncomplying information **not** being considered. See 37 CFR 1.97(i).

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to **a single paragraph** on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The

abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

In this application, the abstract should be in the form of a single paragraph.

Claim Objections

a) Claims 5 and 6 are objected to for being incomplete. The range should be recited as 0.05 to 0.25:1 (for claim 5) and as 0.03 to 0.22:1 (for claim 6).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 10, 11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by the English abstract of Japanese Patent Document No. 63-064,925 (hence "JP-925").

JP-925 discloses a process for obtaining iron hematite particles by subjecting an acidic suspension of FeOOH particles to a hydrothermal treatment.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The person having ordinary skill in the art has the capability of understanding the scientific and engineering principles applicable to the claimed invention. The references of record in this application reasonably reflect this level of skill.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the English abstract of Japan Patent Document 63-064,925 (hence "JP-925") in view of the English abstract of Romanian Patent Document RO 90,697 A (hence "RO-697").

JP-925 discloses a process for obtaining iron hematite particles by subjecting an acidic suspension of FeOOH particles to a hydrothermal treatment.

The difference between the applicants' claims and JP-925 is that applicants' claim 2 sets forth that the treatment occurs at a temperature ranging from 150 to 375 °C (whereas the process of JP-925 occurs at a temperature ranging from 100 to 130 °C).

RO-697 describes a similar process for preparing an iron compound by hydrothermally treating a mixture of Fe_2O_3 and FeOOH at a temperature ranging from 190 to 210 °C with agitation.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of JP-925 by operating the hydrothermal treatment at a temperature of 190 to 210 °C, in a manner that renders obvious the temperature limitations of applicants' claim 2, because RO-697 is evidence that such temperatures of 190 to 210 °C are conventionally used to hydrothermally treat iron-containing materials. It is noted that the particular hydrothermal treatment temperature will be a function of the particular iron-containing materials being subjected to hydrothermal treatment. Note that the courts have already determined that the overlapping portion of a claimed range and a prior art reference's range is *prima facie* obvious: please see the discussion of the *In re Wertheim* 541 F.2d 257, 191 USPQ 90

(CCPA 1976) court decision set forth in section 2144.05 in the MPEP Rev. 3, Aug. 2005.

The difference between the applicants' claims and JP-925 and RO-697 is that the applicants' dependent claims describe the throughput rates; the solids to liquid ratios of the suspension, etc., *however* it is submitted that these differences would have been obvious to one of ordinary skill in the art at the time the invention was made *because* it is reasonably expected that at least an obvious variation of the same processes described in JP-925 and RO-697 will inherently operate at at least obvious variations of the same throughput rates; the same solids to liquid ratios in the suspension, etc. set forth in the applicants' dependent claims.

The following references, which are indicative of the state of the art, are made of record:

U. S. Patent 4,631,089 disclosing color-intensive iron oxide black pigments;

U. S. Patent 4,339,425 disclosing a process for producing acicular hydrated ferric oxide particles;

U. S. Patent 4,289,746 disclosing a hydrothermal treatment of an iron ore, and

U. S. Patent 3,910,784 disclosing a hydrothermal treatment of metal-containing materials.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy C. Vanoy whose telephone number is 571-272-8158. The examiner can normally be reached on Mon-Fri 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Timothy C Vanoy
Timothy C Vanoy
Patent Examiner
Art Unit 1754

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